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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,981	01/23/2006	Peter Dam Nielson	800.0176.U1(US)	7515
29683	7590	10/06/2010		
HARRINGTON & SMITH 4 RESEARCH DRIVE, Suite 202 SHELTON, CT 06484-6212			EXAMINER HARRELL, ROBERT B	
			ART UNIT	PAPER NUMBER
			2442	
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			10/06/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,981	Applicant(s) NIELSON ET AL.	
	Examiner Robert B. Harrell	Art Unit 2442	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) 15-57 and 78-109 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 58-77 and 110-114 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20050614</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-114 are presented for examination.
2. The 26 April 2010 restriction requirement is hereby incorporated by reference into this Office Action and made FINAL.
3. The applicant's 24 August 2010 election, without traverse, is acknowledged. A clear indication of traversal preserves the applicant's right to petition to have the restriction removed; hence, there must be a clearly indication on the record if such an election is or is without traversal.
4. Claims 1-14, 58-77, and 110-114 remain for examination.
5. The title of the invention is not descriptive to the elected invention. A new title is required that is clearly indicative of the elected invention to which the claims are directed.
6. The applicant should always use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols [®], where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., *provide proper antecedent basis for "the" and "said" within each claim*) with each claim ending in a period. Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;
8. *Claim 1-14, 58-77, and 110-114 are rejected under 35 U.S.C. 102 (e)* as being anticipated by Gourraud (United States Patent Application Publication Number: US 2004/0037406 A1).
9. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW

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through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

10. Per claim 1, Gourraud taught a mobile (cellular radio) telephone (e.g., see paragraph [0026]) terminal (e.g., see figure 1 (124 UE)) arranged to provide a user with a selectable option (e.g., see Abstract) during a telephone call (e.g., see Abstract) with a first party, the selection of which initiates communication with the first party by instant messaging (e.g., see Abstract, figure 2 (212) then (214), and paragraph [0027]).

11. Per claim 2, Gourraud also taught that the terminal automatically initiates communication with the first party by instant messaging after user selection of the provided option without further user intervention in figure 2 (218) and paragraphs [0027] to [0030].

12. Per claim 3, claim 4, and claim 5, paragraph [0027] clearly indicates that UE A 202 desired to send an instant message to the other participant(s) during the call and hence it was anticipated UE A 202 activated either a drop down menu or button (key) during the telephone call.

13. Per claim 6, claim 7, claim 8, claim 9, claim 10, claim 11, and claim 12, instant messaging required subscribers to logon to the instant messaging server per the Camel Service Environment of figure 1 with convention instant messaging connection per figure 2 (URI) which was obtained from UE A 202's memory (database) normally as either a "buddy list" or "address book" or "phone book", each common elements of instant messaging selectively displayed during cell phone usage.

14. Per claims 13, 14, 58-77, and 110-114, these claims do not teach or define above the correspondingly rejected claims and are thus rejected for the reasons given above. Since Gourraud taught the use of mobile cellular radio telephone, as indicated above, then such limitations as missed and received calls was anticipated by the applied evidence of record including text messaging.

15. **A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).**

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Thursday from 5:30 am to 2:00 pm.

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17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Asad Nawaz, can be reached on (571) 272-3988. The fax phone number for all papers is (571) 273-8300.

18. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Robert B. Harrell/
ROBERT B. HARRELL
PRIMARY EXAMINER
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